

REMARKS

Claims 1-29 are pending in this application. Claims 1-29 have been rejected. Claims 1, 4, 5, 9, 12, 13, 17, 20, 21, 26, 28 and 29 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate support for the amendment is found at the originally filed claims and disclosure, including page 14, lines 9-29; and page 15, Example. Applicants submit that the present Amendment does not generate any new matter issue. Accordingly, entry and consideration of the amendment are respectfully requested.

Claims 1-30 were rejected under 35 U.S.C. § 102(b) as being anticipated over Yamana et al. (U.S. Pat. No. 5,965,496, hereinafter "Yamana"). The Examiner stated that the claims were anticipated over Yamana in view of the lubricant of example 1 as applied to a carbon coated hard disc in example 7 and formula 1'. In response to Applicants' arguments filed July 10, 2003, the Examiner asserted that the compounds disclosed by Yamana appear to contain a HALS moiety (i.e. =N-O^{*}). The Examiner relied on Diveley et al. (U.S. Pat. No. 4,520,171) and stated that Diveley et al. disclose that =N-O^{*} is considered a hindered amine and light stabilizer. Applicants respectfully traverse.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). In imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann*

Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant differences between the claimed invention and the method and device disclosed by Yamana that would preclude the factual determination that Yamana identically describe the claimed inventions within the meaning of 35 U.S.C. § 102.

Specifically, each of independent claims 1, 9, 17 and 26 recites, in pertinent part, a HALS moiety that is a piperidine derivative having a hydrogen atom at the 1-position and a reactive group at the 4-position of the piperidine derivative. Applicants respectfully submit that Yamana does not disclose a HALS moiety at one or both ends of the perfluoropolyether chain, wherein the HALS moiety is a piperidine derivative having a hydrogen atom at the 1-position and a reactive group at the 4-position thereof. Rather, Yamana discloses that Z1, Z2 and Z3 are a group containing an organic free radical. See col. 2, lines 19-20 and col. 3, line 4 through col. 4, line 15. Yamana, at col. 22, Example 1, discloses the reaction between a nitroxide (Tempol -- 4-hydroxy-2,2,6,6-tetramethyl-4-piperidine-1-oxyl) and a fluorine containing polyether. Tempol contains an organic free radical ($=N-O^*$), wherein the oxygen atom is at the 1-position of the piperidine. Thus, Yamana does not disclose every limitation of independent claims 1, 9, 17 and 26 and, therefore, the rejection is not viable. Further, there is no teaching, suggestion, or motivation to do so found either explicitly or implicitly in Yamana or in the knowledge readily available to one of ordinary skill in the art in to substitute a free radical (O^*) for a non-free radical (H). *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

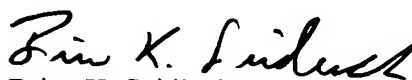
Moreover, Yamana discloses that the organic free radicals tethered on the lubricants are for the purpose of enhancing lubricant bonding on an overcoat. However, according to the present invention, the stability of perfluoropolyether-based lubricants utilized in the manufacture and use of thin film magnetic and/or MO recording media in disk form, particularly against acid-catalyzed catalytic composition (as in the presence of a Lewis acid, such as Al_2O_3), is significantly improved by synthetic attachment of at least one Hindered Amine Light Stabilizer ("HALS") moiety to at least one end of a generally linear chain perfluoropolyether compound. See pages 13-14 of the specification and FIGS 1 and 2.

It is believed that all pending claims are now in condition for allowance. Applicant therefore respectfully requests an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicant's representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Date: December 18, 2003